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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,960	12/03/2003	James P. Beckham	14673-028C1	4367

61263 7590 04/18/2007  
PROSKAUER ROSE LLP  
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WASHINGTON, DC 20004

EXAMINER
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MCCORKLE, MELISSA A

ART UNIT	PAPER NUMBER
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3763

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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## Office Action Summary

Application No.

10/726,960

Applicant(s)

BECKHAM, JAMES P.

Examiner

Melissa A. McCorkle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02072007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This Non-Final rejection is in response to amendments and remarks filed 02/07/2007.

Even though a new rejection has been established below using newly found art, the Examiner still feels that the Hamlin reference is readable upon the current claims and the new rejection is not admitting that the claim amendments overcome the prior art of record.

#### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 10/726,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because the longitudinal length and the interior surface area are measurements. One of ordinary skill in the art would not

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expect these devices to perform differently. MPEP 2144.04 states, "where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device." In the previous office action the Examiner did not say that these were the same measurement; rather that they are measurements of the same area of the device. They are both measurements of the same medical balloon.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-14, 17-28, 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Hamilton et al (5,797,877). Hamilton discloses a non-compliant medical balloon, where the non-compliant medical balloon 24 may be changed from a deflated state to an inflated state by increasing pressure applied to an interior surface of the balloon, comprising a first fiber layer 34 having fibers and at least one fiber disposed along a longitudinal length of the non-compliant medical balloon, a second fiber layer 36

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having fibers, the second fiber layer disposed over said first fiber layer such that the fibers of the first fiber layer and the layers of the second fiber layer form an angle [figure 1], a binding layer [column 4 lines 36-39] that secures the first fiber layer to the second fiber layer so that the first and second fiber layers are restricted from substantial relative movement during inflation and deflation.

5. He discloses the device above, wherein said first fiber layer comprises inelastic fibers [it is non-compliant, which is made of materials that are inelastic, one property of non compliant balloons is that they are made of inelastic materials], a plurality of parallel first and second fibers [layers of PET, PET is a type of fiber], further comprising an adhesive layer adhering to said first fiber layer [col 6 line 35], wherein said angle is a right angle [fig 2A], wherein said angle does not change when the balloon changes from a deflated state to an inflated state; wherein said plurality of parallel first fibers are substantially parallel to the longitudinal axis of the balloon [fig 1]; wherein said plurality of parallel second fibers are substantially transverse to the longitudinal axis of the balloon [fig 2a]; wherein said binding layer or film is a polymeric coating formed of a polymer or copolymer [ col 4 line45], further comprising a third fiber layer [fig 2d] on said second fiber layer; wherein the second fiber layer is positioned substantially perpendicular to the first fiber layer [fig 2d]; wherein the first fiber layers are each substantially equal in length to the longitudinal length of the base layer [fig 1]; wherein each of the fibers is substantially equally spaced from each other, wherein the first and second fibers are inelastic, wherein the fibers are comprised of PBT [col 3 line 58], and

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the base is of PET [col 4 line 22]. The fiber layers have a thickness of about .0005 inch [col 4 line 23].

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 15, 16, 29, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton et al (5,797,877). Hamilton discloses the device as stated above, with the exception of explicitly stating the wind density and ranges in lengths of the sets of fibers. Where the only difference between prior art and the current claims in a recitation of the relative dimensions, one would not expect Hamilton's device to perform differently than applicant's device. Applicant has not disclosed that these measurements provide an advantage, are used for a particular purpose, or solves a stated problem. Furthermore it is not inventive to discover the optimum or workable ranges by routine experimentation. Therefore it would have been prima facie obvious to modify Hamilton to obtain the current invention because such a modification would be considered a mere design choice which fails to patentably distinguish over the prior art.

***Conclusion***


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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa A. McCorkle whose telephone number is (571) 272-2773. The examiner can normally be reached on Monday - Friday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**NICHOLAS D. LUCCHESI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3763**

Melissa A McCorkle  
Examiner  
Art Unit 3763